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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,526	01/29/2001	Otto Dobrounig	ADI-020CN	9695
51414	7590	08/09/2005	EXAMINER	
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/771,526	Applicant(s) DOBROUNIG, OTTO	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 24-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,3-12 and 24-27 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-12 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment defines an outer skin that is seen as elements (12, 13, 20). The amendment also states that each layer complex comprises a plurality of pre-bonded layers. Neither the originally filed specification nor the originally filed Figures disclose that the backing (12) and the middle (13) layer complexes may comprise a plurality of pre-bonded layers. The backing layer is described as comprising two to four separate fabric layers, however, the language "pre-bonded layers" is not used in the description.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-7, 9-12 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste (4,154,789) and Aoyama (5,688,192). Note the basis for the rejections set forth in the Office Action mailed March 14, 2005. Regarding the

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added limitation for claim 1, insofar as this limitation may be understood, Mills discloses the claimed structure. Mills provides a plurality of layer complexes including a first inner layer complex (12) and a second outermost layer complex (13, 14, 15) that forms the top layer complex for the ball. Regarding the limitation for the layers to be “pre-bonded”, Mills teaches bonding the layers together to form a cohesive structure. Further, the language “pre-bonded” is considered to be a product-by-process limitation within the claim. See MPEP 2113. The limitation is met if the end product of the instant invention is the same as or obvious from the product of the prior art.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste (4,154,789), Aoyama (5,688,192) and Kennedy (5,091,265). Note the basis for the rejection set forth in the Office Action mailed May 20, 2003.

Response to Arguments

6. Applicant's arguments filed June 16, 2005 have been fully considered but are not deemed to be persuasive. Regarding the applicant's arguments directed to the rejection under 35 U.S.C. 102(b), these arguments have been fully considered and the rejection has been withdrawn.

Regarding the rejection under 35 U.S.C. 103, attention is directed to the basis for the rejection stated above and the rejection under 35 U.S.C. 112, second paragraph, stating that the claim limitations are indefinite and considered to be new matter. Insofar as they may be understood, the reference to Mills teaches the added claim limitations by providing the inner layer complex and the outermost layer complex (13, 14, 15). Further, the limitation for the layers to be pre-bonded relates to the method steps for producing the ball. See MPEP 2113. In an apparatus claim, the claim limitation is taught if the final product for both the claimed

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invention and the prior art are the same. Here, both inventions will produce a ball with layers bonded to one another.

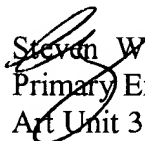
Regarding the rejections of claims 8, 9, 26 and 27, the reference to Kennedy is relied upon solely for its teaching that it is well known in the art to use an aliphatic material in the construction of a game ball. The references to Mills, Aoyama and Delacoste teach the limitations relating to the layer complexes and the syntactic material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
August 4, 2005